

REMARKS/ARGUMENTS

In the above-mentioned Office Action, claims 23-41 were rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,307,468; claim 41 was rejected under 35 U.S.C. §112 ¶2, claims 23-25, 27, 31 and 32 were rejected as being unpatentable for Balch et al., claims 37-39 were rejected as being unpatentable over Balch et al. as applied to the claims above and further in view of Hess, Jr. et al., claim 41 was found to be allowable if rewritten to overcome the indefiniteness rejection, and claims 26, 28-30, and 33-36 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Responsive thereto, claim 33 has been amended to correct a typographical error, claims 40-41 have been cancelled and new claims 42-62 have been added.

In response to the obviousness-type double patenting rejection, submitted herewith is a terminal disclaimer.

The indication of allowable subject matter in claims 26, 28-30, and 33-36 is acknowledged with appreciation. These claims have not been rewritten in independent format because Applicant respectfully contends that the independent claims from which they depend are allowable. In particular, Applicant contends that the rejections over a Balch et al., are improper.

Balch describes a system that abruptly alternates between in-phase and out-of-phase operation, rather than smoothly and continuously rotating the phases. The discontinuity between alternations involves generation of harmonic frequencies which cause outside interference, waste energy, and requires a recovery period for the receiver to resume operation after the phase switch. In other words, Balch is apparently pulsing the magnetic field as a work-around for the signal disturbance caused by the abrupt phase switching he uses. Balch uses a two-step process. (See Column 8, line 55.) First he searches for a tag by pulsing the magnetic field with alternating phases, then he holds the best phase for actually validating the tag.

The examiner stated in his action that "it is noted that Balch does not reference a time varying composite magnetic field. The skilled artisan recognizes that the alternately generation of pulsed magnetic field phases is clearly analogous to the claimed composite magnetic fields. It would have been obvious to one having ordinary skill in the art to equate the claim to magnetic field component or composite magnetic field with the reference pulsed magnetic fields and the characteristic response." (Emphasis Added)

It is first noted that the examiner has stated that "alternately generation of pulse magnetic fields is clearly analogous to the claimed composite magnetic fields." To the extent that this statement was intended to convey that the examiner has taken "judicial notice" with respect to knowledge generally available in the art, Applicant hereby traverses and requests that the examiner provide an affidavit in accordance with MPEP 2144.03 and 37 CFR 1.104(d)(2). Otherwise, Applicant respectfully requests that the examiner provide a prior art reference which shows this knowledge in the art.

In this rejection, the examiner stated that it would be have been obvious to one having ordinary skill in the art to equate the claim magnetic field component with that the reference magnetic field. Applicant respectfully contends that "equating" elements is not a proper Section 103 test.

If the examiner is stating that it would have been obvious to modify Balch with the alleged prior art teachings, it is respectfully requested that the examiner provide a showing of a suggestion, teaching or motivation to combine the prior art references as this is "an essential component of analogous holding." *In re Lee*, 61 USPQ 2d 1430, 1433 (Fed. Cir. 2002), citations omitted. The burden of showing obviousness may be satisfied "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would leave that individual to combine the relevant teachings of the references." [*Id.* at 1434, citations omitted.] Here, there is no reason, other than hindsight attempt to replicate the claim combinations, to combine the cited references in the manner proposed in the office action, Applicant respectfully contends.

Further, in *Winner International Royalty Corp. v. Wang*, 48 USPQ2d 1139, 1144 (Fed. Cir. 1998), the Federal Circuit reiterated the fundamental rule that "it is insufficient to prove that at the time of the claimed invention, the separate elements of the device were present in the known art." To the contrary, "there must have been some **explicit** teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention." *Id.* [Emphasis added.] Thus, "[o]ne cannot use hindsight reconstruction to pick and chose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

In the examiner's obviousness rejection of claims 37-39, he stated that "it would have been obvious to one of having ordinary skill in the art to provide a composite magnetic field, which rotates in the interrogator system of a Balch since the use of a composite magnetic field, which rotates in an interrogation system, is clearly suggested by Hess."

Again, the examiner has not shown any type of suggestion, teaching, or motivation to combine Balch and Hess. He merely stated that composite magnetic fields, which rotate in interrogation systems, are clearly suggested by Hess. He did not state where there is the showing or suggestion to combine.

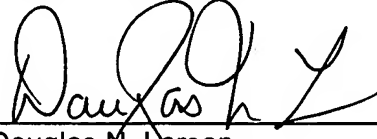
Accordingly, withdrawal of the rejections and allowance of all of the pending claims are in order and are respectfully requested.

New claims 46-62 are patentable because there is no suggestion in the prior art of "a plurality of coils positioned relative to one another and adapted so as to generate a composite rotating magnetic field having an approximately constant amplitude in all orientations relative to a transponder."

If there are any remaining issues, the examiner is encouraged to telephone the below-signed counsel to seek to resolve them at (213) 689-5142.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 07-1853. Should such additional fees be associated with an extension of time, Applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,



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